

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Jang (Pvt) Ltd v. Muhammad Tahir

Case No. C2009-0001

Also in PDF C2009-0004

1. The Parties

The Complainant is Jang (Pvt) Ltd, having its principle premise of business at Printing House, I.I. Chundrigar Road, Karachi-74200, Pakistan. The Complainant is an organization that is the proprietor of, among other media concerns, the Daily Jang, considered to be the world's largest Urdu language newspaper. The Complainant is also trading as a registered company under the name of Jang (Pvt.) Ltd.

The PKNIC Whois data base shows the registrant of the domain name in dispute <jang.pk> to be Mr. Muhammad Tahir.

2. The Domain Name and Registrar

The Respondent is Mr. Muhammad Tahir, A-22, Phase V, Sunset Club, DHA, Karachi. The domain name in dispute <jang.pk> has been created on 20th June 2006 at 01:38:19 (all times mentioned are Pakistan Standard Time – PST).

3. Procedural History

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 6th June, 2008

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], DNDRC formally notified the Respondent of the Complaint via email dated August 20th, 2008, 20:54 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC and submitted their contentions via email dated 26th August, 2008 19:45. DNDRC emailed the Respondent yet again on the 29th of August,

2008 at 15:11 to reiterate the necessity of providing a reply via the response form and allowed the Respondent one further opportunity of complying with the procedure of the DNDRC. The Respondent however disregarded this opportunity and failed to provide a response in the required manner. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter based upon the Complaint. However in the interest of completeness the Panel has considered the response provided via email by the Respondent in a limited capacity and dealt with the contentions raised within the same as far as the Panel deemed necessary (however this is not intended to create any binding precedent requiring the same to be followed in the future). The proceedings commenced on 19th of September, 2008.

The Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.1, state that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

The Center has delayed decision on this matter due to procedural non-compliance, as allowed under section 10(2) of the Supplemental Rules of DNDRC. Upon fulfillment of such procedure, applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Mr. Mustafa Syed as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. He has accepted and declared Impartiality and Independence.

The language of the proceedings is English, being the language of the registration agreement.

4. Factual Background

The Complainant is the registered proprietor of the trade mark “Jang” Class 16, registration number 106183. This trade mark is closely associated and synonymous with the Complainant’s business of printing and publishing of newspapers as well as other related media concerns being carried out of the past twenty years.

The Respondent registered the disputed domain name <jang.pk> on 20th June, 2006 in his name. The Complainant has provided evidence that up till the 1st of July, 2008, the domain

name in dispute was being used to offer services relating to news, television channels, job opportunities, business ventures, videos and other news related products. In addition, the domain name is also available to be purchased. (PDF document attached as annexure)

Additionally the Respondents have failed to provide DNDRC with a Response to the complaint initiated against them in the required form by under section 6(1) of the Supplemental Rules of DNDRC despite a reminder being sent by DNDRC to the Respondent requesting him to do so.

5. Status of the Website

The Panel has utilized the assistance of DNDRC and the Complainant in determining the functionality of the website as it is pertinent to the proceedings. The Panel has had the benefit of information provided by the Complainant and DNDRC has independently carried out verification of the website.

The Complainant has provided DNDRC with proof pertaining to the status of the website prior to the Respondents had been made aware of the Complain lodged against them. (PDF attached as annexure). In addition to the domain name reflecting the trademark of the Complainant, the website can be seen to offer services that identically similar to the Complainant's business i.e. relating to news, television channels, job opportunities, the website can be seen to provide links titled "Daily Jang Urdu", "Daily Jang News" and "Daily Jang Newspaper" among others, thereby can be seen to be contriving to establish a direct link to the Complainant's business and trade name.

Upon the Panel's request, the Centre visited the disputed domain name on the 29th of August 2008, following the submission of the response via email by the Respondent, the website was found to be altered, as compared to the PDF document captured by the Complainant. The website was under construction and announcing its relation to historical wars, in a manner that could be seen by any reasonable person to be an attempt to lay credence to the Respondent's contentions submitted via email to DNDRC. (PDF document attached as annexure).

To assess the facts in a thorough and well encompassing manner, the Centre paid a final visit to the website on the 21st of April, 2009, and discovered the website to have reverted back to it's original state, as captured by the Complainant prior to lodging their Complaint, i.e. offering services relating to news, television channels, job opportunities, business ventures, videos and other news related products, including the provision of links that directly incorporated the business and registered trade mark of the Complainant, such as "Daily Jang Urdu", "Daily Jang News", "Daily Jang", "Jang Urdu Pakistan" and "Jang Urdu Pakistan". Additionally via a separate link leading off from website, the domain name in dispute is available for sale to the public as well. (PDF document attached as annexure)

6. Parties' Contentions

A. Complainant

The Complainant is the registered owner of the following domain names:

<http://www.jang.com.pk>

<http://www.jang-group.com>

<http://www.jang.net>

The Complainant contends that:

- i. It is a well-known and prominent company that has been engaged in the business of printing and publishing newspapers with significant distribution for over two decades therefore its trade name is closely linked to its operation of business and its customer base is contingent upon its registered trade mark.
- ii. It has developed and registered its registered brand/trade mark, which it uses notably in connection with its well established business of newspapers and motion media. It prints and publishes various other newspapers, several of them incorporating its registered brand/trade mark in them thereby the trademark becoming the Complainants personal insignia that they, their products and their services are recognized and identified by.
- iii. It operates various websites vide domain name(s) including but not limited to the ones listed above, which constitute their trademark as an integral part of them.
- iv. The disputed domain name is identical to the registered trade mark in which the Complainant has rights for the following reasons:
 - a) The Complainant is a well known proprietor of newspapers and other media concerns and has used its registered trade mark in its commodities thus the fact that the disputed domain name comprises of the word "Jang" in relation to offering identical services as the Complainant does, may, by any and all reasonable deduction, be inferred to be identical to the registered trademark of the Complainant.
 - b) The Complainant's use of its registered trade mark is very well known, both nation wide as well as internationally, both in the print and the motion media industry

therefore the disputed domain name of <jang.pk> would inherently be assumed to belong to the Complainant by the general public and the Complainant's clients as the trade mark has been developed by the Complainant solely for the purposes of its own business. Therefore, linked to similar services as well, the name "Jang" would be considered identical to the Complainant's registered trade mark.

- c) That the disputed domain name, <jang.pk>, is identical to the registered trade mark of the Complainant (Complainant has referred to the Uniform Domain Name Dispute Resolution Policy which was adopted by ICANN on August 26, 1999, and forms part of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 para. 4(a), (b) and (c); Rules, para 3). The Complainant relies upon the precedent of *Zwiesel Kristallglas AG v WWW Enterprise Inc.* Case No. D2005-1223, where the Administrative Panel held that:

"for the purpose of assessing whether a domain name is identical or confusingly similar to a trademark or service mark, the suffix ".com" must be disregarded as being simply a necessary component of a generic top level domain name"

The Complainant contends that accordingly, it is well established that the suffix ".pk" must be disregarded as simply being a necessary component of a country code top level domain name.

The Complainant submits that the word "Jang" is the essential element of its registered trade mark and has been reproduced and incorporated entirely within the disputed domain name. The thrust of the registered trade mark is "Jang" and it is this word that makes up the disputed domain name. The disputed domain name is thus identical to the title of the registered trade mark of the Complainant.

- v. The Respondent has no rights or legitimate interests in respect of the disputed domain name for the following reasons:
- a) The Respondent cannot be seen to be making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or without intent to tarnish the trade mark or service mark at issue as they are offering services similar to those offered by the Complainant on the Complainant's websites resulting in the threat of diversion of the Complainant's clients and customers to the domain name in dispute.
- b) Complainant has at no point licensed or allowed the Respondent the use of the entire, or part of, its registered trade mark nor licensed or permitted the use of the entire, or part of, its registered trade mark as part of a domain name not yet under the control of the Complainant but which they might intend to use in future to facilitate their customers and clients further.

- c) The Respondent is not, and has never been, one of the printer(s), publisher(s), distributor(s) or any other business related entity of the Complainant thus has no connection, relevance or rights in the registered trademark of the Complainant prior to the registration of the disputed domain name. Therefore, the Respondent cannot be seen to possess any legitimate interest in the domain name in dispute or its use.
 - d) The Respondent could not fail to be aware of the goodwill and reputation of the Complainant's registered trade name given the extent of the international and national distribution of the Complainant's business for the past twenty years thus the Respondent's registration of the domain name in dispute, with respect to their offering of similar services as the Complainant via such a domain, could not under any circumstances be deemed legitimate.
 - e) The Respondent is not commonly, or otherwise, known by the disputed domain name, unlike the Complainant, nor has he acquired any rights in the name, or similar names.
 - f) The Respondent has made no legitimate, non-commercial or fair use of the disputed domain name as he offers services in direct competition to the Complainant on the disputed domain name and the Complainant has been hindered from registering the disputed domain name in its own name as it has already been registered by the Respondent.
- vi. The domain name in dispute was registered and is being used in bad faith by the Respondent. This contention is supported by the following:
- a) The Respondent is using the disputed domain name in a manner that is intended towards attracting Internet users to his own website by creating a link with the well established registered trade mark of the Complainant, in order to intercept users who wish to access the Complainant's website. The Respondent could not have failed to be aware that infringement of the Complainant's rights with respect to their registered trade mark would be taking place by the registration of an identically similar domain name.
 - b) The Respondent had to be aware of the Complainant's registered trademark since both the Complainant and the Respondent operate in the same country and the Complainant is the proprietor of numerous well-reputed newspapers with various other commodities in the same industry as well as motion media in the form of television channels, all prominently displaying its registered trademark.
 - c) The Respondent could not fail to be aware of the repute of the Complainant's trademark and it's similarity to the domain name in dispute, thus this constitutes proof of the Respondent's bad faith, corresponding to which the Respondent registered the disputed domain name with the apparent intent to prevent the

Complainant from registering the same domain name for the purposes of facilitating the Respondent's offline selling to customers of the Complainant.

- d) The Respondent has no affiliation and/or association with the Complainant and is diverting the latter's customers by creating a web-site leading off from the disputed domain name <jang.pk> that is identical to the Complainant's trade mark and is offering similar services (online news) via such a website in direct competition with the Complainant's business. The Respondent has used the same trade mark belonging to the Complainant knowingly, deliberately and in bad faith to gain benefit from the sterling reputation of the Complainant that the Complainant has built over two decades. There is no evidence of the disputed domain name being put to any use that may amount to good faith.
- e) The Respondent is diluting the registered trade mark of the Complainant. In CSA International (a.k.a Canadian Standards Association) v John O' Shannon and Care Tech Industries, Inc Case No. D2000-0071 the Administrative Panel held that:

“the adoption by the Respondents of an Internet address substantially identical or confusingly similar to that of the name, Internet address and trade marks of the Complainant must inevitably and misleadingly divert consumers to that address and have the effect of tarnishing the trade marks”.

- f) The Respondent has put the disputed domain name up for sale thereby providing substantial evidence of the fact that the disputed domain name has indeed been registered in bad faith and for the Respondent's monetary gain at the expense of the Complainant's business and registered trade mark.

For all the above reasons, the Complainant requests a transfer of the disputed domain name.

B. Respondent

The Respondent failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC and submitted their contentions via email dated 26th August, 2008 19:45. DNDRC emailed the Respondent yet again on the 29th of August, 2008 at 15:11 to reiterate the necessity of providing a reply via the response form and allowed the Respondent one further opportunity of complying with the procedure of this Panel. The Respondent however disregarded this opportunity and failed to provide a response in the required manner. Via the email the Respondents contended that:

- i. The domain name <[jang.pk](#)> is based on the Urdu dictionary word “Jang” meaning “WAR”.

- ii. The Respondent registered the disputed domain name to launch an informative web portal on Historical Wars, especially Jang-e-Aazadi 1857, Wars of 1965, 1971 & Kargal.
- iii. The disputed domain name is not related to the Jang newspaper in any manner. The Complainant's claim on the disputed domain name would have been correct if the domain registered by the Respondent was "Jangnews.pk" or "Jangnewspaper.pk".
- iv. As per ICANN policy generic dictionary names cannot be claimed by any company despite it being their registered trademark.
- v. The PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 also states:

"There is no restriction for generic dictionary names, and these can be registered under any .pk name"

- vi. Thus <[jang.pk](#)> is a generic dictionary name and cannot be claimed by any company.

Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence the proceedings in default and to determine the matter based upon the Complaint. However in the interest of completeness the Panel has considered the response provided via email by the Respondent in a limited capacity and dealt with the contentions raised within the same as far as the Panel deemed necessary (however this is not intended to create any binding precedent requiring the same to be followed in the future).

7. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules.

The Respondent applied for, was granted, registration of the disputed domain name on the basis of, and has submitted to, the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

8. Discussion and Findings

The application for the registration of the domain name in dispute <[jang.pk](#)> on behalf of the Complainant is regulated by the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and the UDRP Rules. The PKNIC Policy states:

“You, the applicant who wants to register a domain name under .PK is presumed to have read and agreed to this PKNIC Internet Domain Registration Policy”.

The Respondent applied for registration of the disputed domain name <jang.pk> on the basis of these regulations and was allowed registration subject to the same. Hence the relationship between the Respondent and PKNIC with respect to PKNIC’s domain name registration service is governed by the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 and the UDRP Rules, thus the Respondent’s registration must be legitimate as per the requirement of these regulations and Rules.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 6 states that:

*“PKNIC has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents, agrees and warrants the following four statements and a **failure to comply with them, or any other parts of the PKNIC policy, will cause PKNIC to cancel the domain registration of the non-compliant domains of Applicant:***

- 1. Applicant's statements in the application are true and **Applicant has the right to use the Domain Name** as requested in the Application;*
- 2. Applicant has a **bona fide intention to use the Domain Name on a regular basis on the Internet;***
- 3. The use or registration of the Domain Name by Applicant **does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;***
- 4. Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or **for the purpose of confusing or misleading a person, whether natural or incorporated.**”*

Correspondingly the UDRP lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall be decided:

- (i) Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and*

(iii) Respondent's domain name has been registered and is being used in bad faith.

Therefore in the present context the decision of the dispute shall be addressed with respect to the following aspect:

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).
- ii. Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).
- iii. Legitimate interest in the domain name (a UDRP criteria).
- iv. Registration and use of the domain name in bad faith (a UDRP criteria).

I. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration of the domain name

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, a domain name is registered subject to inter alia paragraph 1 & 4 and is held invalid if it:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. in the opinion of PKNIC is not appropriate for registration.*

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 4 also states that:

If a party claims that a domain name already registered with PKNIC violates their registered trade name, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates the right to cancel or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution

Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Hence, any registration of a domain name, in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007. ver 4.2, would be ab initio void and as well as voidable under the requirements of paragraph 4 of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

For the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration in order to determine whether the application and registration of the domain name in dispute “<[jang.pk](#)>” is ab initio illegal with respect to the following aspects in the context of which this dispute shall be assessed:

- i. Whether the domain name in dispute “<[jang.pk](#)>” infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the domain name in dispute “<[jang.pk](#)>” is bona fide?
- iii. Whether the application and/or registration of the domain name in dispute “<[jang.pk](#)>” contravene the Pakistan Penal Code or any applicable criminal law?

The Panel will deal each of these sub-issues sequentially below.

- i. Whether the Domain Name in dispute “<[jang.pk](#)>” infringes upon a registered trade name / trade mark?**

The Respondent has submitted that the domain name in dispute <jang.pk> would not constitute infringement of the Complainant’s registered trade mark as domain names “Jangnews.pk” or “Jangnewspaper.pk would. However it is the Panel’s opinion that the disputed domain name would by all reasonable deduction be considered to be identical to the Complainant’s registered trade mark of the Complainant that is used by the Complainant with respect to the products and services it offers to a large national and international market. As a precaution to such infringement the Complainant has registered the similar domain names of <http://www.jang.com.pk>, <http://www.jang-group.com> and <http://www.jang.net> in order to protect and facilitate its customers and its products.

Following the above, it may be reasonably deduced, and in the Panel’s opinion, proves that the Complainant has taken the necessary steps, not just to protect their trade marks, and any obvious derivations thereof, but also their domain names that relate to such trade marks however the actions of the Respondent prevented the Complainant from registering the disputed domain name <jang.pk> in continuance of such protection of their registered trademarks and any obvious derivations of them.

Paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 sets out the condition that if a Complainant simply establishes this one criterion of infringement upon a

registered trade mark the registration of the disputed domain name would be deemed illegal, unlawful and, for all purposes, invalid. The same stand proves and constitutes adequate grounds for the transfer of the domain name in dispute “<[jang.pk](#)>” to the Complainant.

Nonetheless for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

ii. Whether the application and/or registration of the Domain Name in dispute “<[jang.pk](#)>” is bona fide?

It is the opinion of the Panel that in order to determine this sub-issue, an analysis of the possible intentions of the Respondent behind the registration of the domain name in dispute “<[jang.pk](#)>” is required. This shall assist the Respondent in inter alia establishing the bona fide nature of the registration and countering the argument that the registration of the disputed domain name is neither illegal nor intended to maliciously deprive the Complainant from the use of the domain name and creating confusion amongst the users and customers of the Complainant by virtue of the similarity and identical nature of the disputed domain name to the Complainant’s domain names, trade marks and trade names.

In this respect, it is a pertinent fact that the Respondent could not fail to be reasonably aware of the reputable nature and large customer base of the Complainant at the time when the Respondent registered the domain name in dispute “<[jang.pk](#)>”. The Panel takes into account the WIPO decision of **Hollywood Foreign Press Association v. F.M.I. Case No. D2008-1610**, whereby it was noted that:

“The Complainant contends that the Respondent registered the Domain Names knowing of the existence of the Complainant’s trade mark, GOLDEN GLOBE, and with a view to exploiting the Complainant’s trade mark rights, a primary claim being that the Respondent registered the Domain Names with a view to selling them at a profit. If the Complainant’s allegations are made out, such a registration could not conceivably give rise to rights or legitimate interests in respect of the Domain Names. The Panel accepts the Complainant’s unchallenged contention that it is inconceivable that the Respondent was unaware of the Complainant’s mark, GOLDEN GLOBE, when the Domain Names were registered. The Complainant has undertaken various enquiries and has found no basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Names. Moreover, the Respondent’s name has no obvious connection with the Domain Names and the Complainant has granted the Respondent no license in respect of the GOLDEN GLOBE trade mark. The Complainant has made out a prima facie case under this head, a case calling for an answer from the Respondent. The Respondent has not responded to the Complaint; nor did the Respondent respond to letters from the Complainant’s representative. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.”

In the present case the fact that both parties are present within the same geographic location and that the Respondent would, by reasonable deduction, be well aware of the existence and value of the Complainant's trademark, existing domain names and customer base, is indicative of substantial proof that the Respondent's registration of the domain name in dispute "<jang.pk>" lacks bona fide.

Moreover, the fact that the Respondent chose specifically to register a domain name identical to, the Complainant's trade name is highly relevant to the consideration of the Respondent's lack of bona fide. Furthermore the Respondent offers services and products similar to and in direct competition to the products and services offered on the Complainant's website which is clearly indicative of lack of bona fide on the part of the Respondent.

The Respondent has contended that the disputed domain name is not related to the Complainant's trade name, and is in fact based on the Urdu translation of the word "Jang" meaning "war". Despite proper documentation and evidence not provided via the required Response format, the Panel has considered the Respondent's contention in a limited manner. However, the Complainant has provided conclusive evidence regarding their contention that the domain name in dispute, prior to the Respondent being made aware of the Complaint, was offering services in direct competition with the Complainant, namely services related to online news and media related. Subject to the conclusions drawn from the Centre's investigation regarding the status of the website, as discussed in Section 5 of this decision, the Panel accepts the Complainant's contentions regarding the Respondent's lack of bona fide due to evidence of the Respondent's deliberate attempt to alter the website for a limited period following the lodging of the Complaint and the subsequently resuming the same website that was used to make use of the Complainant's registered trade marks to offer links to identically similar services and products as provided by the Complainant.

Hence it this Panels opinion that the Respondent's mala fide is evidenced by their attempt to mislead this Panel and temporarily alter the contents of the domain name in dispute to validate their false contention , therefore the Respondent's lack of bona fide is evident not only by their registration of a domain name that is identical to the Complainant's registered trade mark but also by their inaccurate submission made to this Panel.(PDF documents of the domain name in dispute have been submitted as annexure)

Additionally the domain name in dispute is available to be bought as can be seen by a link leading off from the website, thereby casting doubt upon the Respondent's bona fide interest in the domain name in dispute <jang.pk>.

Thus, due to failure on the part of the Respondent to provide acceptable justification regarding the alleged non-commercial purpose and lack of bona fide behind the registration of the disputed domain name, the Respondent's have not been able to disprove the allegation against them that there exists no legitimate and non-commercial purpose in conformity with the

PKNIC- Internet Domain Registration Policy Aug 7, 2007 ver 4.2 under which the Respondents initially registered the domain name in dispute “<[jang.pk](#)>”.

As per the requirements of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2, if a Complainant simply establishes this one criteria the registration of the domain name in dispute would be deemed illegal, unlawful or otherwise invalid. As such since, in the opinion of the Panel, this criteria has been established by the Complainant within their Complaint and no suitable evidence to the contrary has been tendered by the Respondent thus the Panel has determined the issue on the same stands and constitutes adequate grounds for the transfer of the domain name in dispute “<[jang.pk](#)>” to the Complainant.

iii. Whether the application and/or registration of the Domain Name in dispute “<[jang.pk](#)>” contravene the Pakistan Penal Code or any applicable criminal law?

Prior to proceeding with this analysis the Panel feels compelled to clarify the basis and effect of this sub-issue. It is clarified that although Pakistani law does not apply by force of law over PKNIC’s Jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy Aug 07, 2007, version 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

In this spirit and for this purpose alone the following provisions of Pakistani law are being analyzed.

Trade Marks Ordinance, 2001

“40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

4. Domain name not to be misleading as to character or significance.- (1) A domain name shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.

Pakistan Penal Code, 1860

Of Trade, Property and Other Marks

1[478. Trade mark. A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940).]“

The disputed domain name provides an option for a visitor to the website to enquire regarding the purchase of the disputed domain name, thereby casting doubt upon the bona fide of the Respondents with respect to the domain name in dispute and creating the possibility of infringement under the terms of the above section 40 of the Trademarks Ordinance.

Furthermore the Trade Mark Ordinance equates infringements of Trade Marks and Trade Names with the infringement of domain names hence, under the Trade Mark Ordinance; provisions of the Pakistan Penal Code that deal with infringement of Trade Marks would possibly also cover domain names.

The Electronic Transactions Ordinance, 2002 (“ETO”)

“3. Legal recognition of electronic forms.—No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

As such all material, documents or instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract and be subject to the provisions of the same sections of the Penal Code or any law had the material been in physical, written or printed form. Thus, the Penal Code applies equally to transactions, publications or material including the use of any trade mark or trade name made available in electronic form on the Internet through the use of a domain name as it does to physical material.

Since the Internet by its very nature is a public domain, obtaining access of the domain name that may involve use by the registrant of a registered trade mark or trade name in the form of a domain name by an entity other than the owner/rightful holder/authorized user of the trade mark or trade name for the purposed of export and import of data, would result in a violation of trade

names or trade marks by virtue of access to such a domain as well as to the content as at the very least, use of Search engines by the public, would attract offences *inter alia* mentioned below under the Penal Code.

By the continuing registration of the domain name in dispute “<jang.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade mark “Jang”, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

Pakistan Penal Code, 1860

479. Property mark. A mark used for denoting that movable property belongs to a particular person is called a property mark.

480. Using a false trade mark. Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

As such the use of the domain name in dispute “<jang.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade mark “Jang” could constitute an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

“481. Using a false property mark. Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

482. Punishment for using a false trade-mark or property mark. Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

Section 481 provides not only for movable goods but moveable property as well. As such it may logically be extrapolated that the inclusion of the words “movable property” in addition to

the words “goods” suggests that the draftsman and legislature intended “movable property” to refer to items other than, and in addition to, “goods” and as such intellectual property or now, with the aid of the ETO digital property, any “*document, record, information, communication or transaction*” in electronic form would also be covered under this section. Hence, it would include any electronic means of encasing, packaging, containing intellectual property or property which is movable other than goods i.e. including domain names or any content on the website hosted on the domain name in dispute “<[jang.pk](#)>”.

As such the concept of use of a false property mark (which includes trade marks and by virtue of both the Trade Marks Ordinance, 2001 and international best practices) includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages (received from the website hosting the domain name) on the Internet with the reasonable expectation that people would be misled into believe that the trade mark, trade name or domain name belongs to the internationally renowned organization of the Complainant, when in fact it does not.

This issue is compounded by the fact that the Respondent offers services similar to those provided by the Complainant on their website, and would thus constitute use of a false property mark in clear violation of the Penal Code.

Therefore the use of the domain name in dispute “<[jang.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark “Jang” could constitute as an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

“483. Counterfeiting a trade mark or property mark used by another. Whoever counterfeits any trade mark or property mark used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.

485. Making or possession of any instrument for counterfeiting a trade mark or property mark. Whoever makes or has in his possession any die, plate or others instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.

473. Making or possessing counterfeit seal, etc., with intent to commit forgery punishable otherwise. Whoever makes or counterfeits any seal, plate or other instrument for making an impression, intending that the same shall be used for the purpose of committing any forgery which would be punishable under any

section of this chapter other than section 467, or, with such intent, has in his possession any such seal, plate or other instrument, knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.”

The use of the domain name in dispute “<jang.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade mark “Jang” to offer services similar to those that are being offered on the owner/rightful holder/authorized user’s website may also be construed to be counterfeiting of the source identifier of the trade name, trade mark and property mark and thus the use of a domain name, apart from being counterfeiting by itself, could at the least constitute possession and use of an electronic instrument being used for counterfeiting a trade mark, property mark or domain name.

“464. Making a false document. A person is said to make a false document: ---

First: Who dishonestly or fraudulently makes, signs, seals or executes a document or part of a document, or makes any mark denoting the execution of a document, with the intention of causing it to be believed that such document or part of a document was made, signed, sealed or executed by the authority of a person by whom or by whose authority he knows that it was not made, signed, sealed or executed, or at a time at which he knows that it was not make, signed, sealed or executed;

470. Forged document. A false document made wholly or in part by forgery is designated “a forged document”.

471. Using as genuine a forged document. Whoever fraudulently or dishonestly uses as genuine any document which he knows or has reason to believe to be a forged document, shall be punished in the same manner as if he had forged such document.

476. Counterfeiting device or mark used for authenticating documents other than those described in section 467, or possessing counterfeit marked material. Whoever counterfeit upon, or in the substance of, any material, any device or mark used for the purpose of authenticating any document other than the documents described in section 467 of this Code, intending that such device or mark shall be used for the purpose of giving the appearance of authenticity to any document then forged or thereafter to be forged on such material, or who, with such intent, has in his possession any material upon or in the substance of which any such device or mark has been counterfeited, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.”

Similarly, the use of the domain name in dispute “<[jang.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark “Jang”, to offer services similar to those that are being offered on the owner/rightful holder/authorized user’s website in a manner that could reasonably mislead the authorized user’s customers/clients, could also be equivalent to the wrongful use of an electronic message or document covered under ETO, 2002. Since, the person making, signing or executing this website, the domain name, its contents, its documents on the site and every message that suggests that the message is being executed by “<[jang.pk](#)>” would be representing and making such a document falsely knowing that he is not authorized to do so, hence the electronic message and document would be false/forged and he would thus, contravene sections 464, 470 and 471 of the Penal Code.

Moreover, section 476 of the Penal Code clearly makes it an offence to possess any device or material (by operation of the ETO 2002 this would extend to electronic instruments or devices including domain names, websites and electronic messages being exchanged between the domain name, the website server and any other party) which is intended to authenticate or give the impression that it authenticates (the domain name would authenticate) a document (the website and domain name or the electronic messages) when in fact such authentication would be incorrect and counterfeit and in breach of the Code.

Electronic Transactions Ordinance 2002

“3. Legal recognition of electronic forms.—No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

Prevention of Electronic Crimes Ordinance 2008

“15. Spoofing.(1) Whoever establishes a website, or sends an electronic message with a counterfeit source intended to be believed by the recipient or visitor or its electronic system to be an authentic source with intent to gain unauthorized access or obtain valuable information which later can be used for any unlawful purposes commits the offence of spoofing. (2) Whoever commits the offence of spoofing specified in sub-section (1) shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both”.

Hence it can be construed that in any event where a Respondent has established or is using a website or a domain for any purpose, in which he does not hold legitimate interests, is entitled

to be charged with the offence of spoofing under s.15 of the PECO 2008. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

Therefore, it is in the opinion of the Panel that the registration and/or use of the domain name in dispute “<[jang.pk](#)>” by the Respondent would be in violation of Pakistani criminal law and the Pakistan Penal Code and therefore as a result of, would constitute a violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

The Panel therefore, concludes that the registration of the domain name in dispute “<[jang.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, not to mention that the Respondent’s registration and/or use of the domain name in dispute “<[jang.pk](#)>” could very possibly give the impression that PKNIC, (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) by allowing the maintenance of such registration, would be committing a contravention of the Pakistani criminal law and a breach of its own Internet Domain Registration Policy Aug 07, 2007 version 4.2.

Although it is evident that the Complainant has succeeded in proving their Complaint in terms of the initial requirements of the PKNIC- Internet Domain Registration Policy June 07, 2007 version 4.2, and the registration of the disputed domain name is to be transferred to the Complainant, this Panel shall also assess the Complainant in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2(which also includes the ICANN UDRP with amendments).

II. Identical or confusing similarity with a trademark or service in which the Complainant has rights

The trade mark “Jang” is the registered trade mark of the Complainant. The addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s users. This concept is strengthened by the fact that the Respondent offers services and products on the disputed domain name that are identically similar and in direct competition with the services and products available on the Complainant’s website. In similar cases, the addition of the suffix “.pk” has not been considered to add any element of distinctiveness (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

In the case of *Atticabank S.A. v. Net Promotion, Inc.* Case No. D2006-0317 the Panel, when discussing the issue of “Identical and Confusingly Similar”, held the following:

“A. Identical or Confusingly Similar

Although the Complainant’s business is primarily based in Greece, the Complainant has for many years used the words ATTICA BANK and BANK OF ATTICA in the English language both as a corporate name and as a trademark

and service mark. The Complainant has built a substantial goodwill in the use of these marks both in Greece and in other jurisdictions throughout the world for its banking and financial services.

The Complainant's Greek registered trademark ATTICA CARD, registration no. 117698, is for a word mark. The Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141534, includes a logo but the registration document expressly includes the words as protected indications. Similarly, Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141535, includes a logo device but again the registration document expressly states that the words are protected indications. Similar protection is afforded to the word elements in the Greek registered trademarks TECHNOCARD – BANK OF ATTICA with logo, registration no. 141535 and ATTICARD EXTRACASH – BANK OF ATTICA with logo, registration no. 143339.

The Complainant has established to the satisfaction of this Panel that it has rights in the trademarks ATTICA BANK and BANK OF ATTICA through long term use, and in addition, it has rights in the marks ATTICA CARD, TECHNOCARD – BANK OF ATTICA and ATTICARD EXTRACASH – BANK OF ATTICA through its Greek registered trademarks.

The domain name <atticabank.com> is clearly identical to the Complainant's trademark ATTICA BANK and is confusingly similar to the Complainant's trademark BANK OF ATTICA.”

The Complainant's registered trade name is very well associated and connected with the services and products provided by the Complainant in their course of business. The same being newspapers, magazines, television channel(s) and news in other forms including, but not limited to, online news provided via the websites/domains registered by the Complainant.

The domain name in dispute <jang.pk> contains the Complainant's trade mark in entirety thus is identical to the Complainant's registered trade mark that the Complainant uses for the purposes of conducting its business.

The use of such a confusingly identical domain name would not only cause confusion to the user(s) and customer(s) of the Complainant but would also hinder the Complainant from registering the disputed domain name for the purposes of provision of online news and other related services in furtherance to their business thus may cause substantial and irredeemable harm to the Complainant.

The Respondent has contended that the disputed domain name is not related to the Complainant's newspaper business as such cannot be considered linked the Complainant's registered trade mark; however this claim could not be substantiated by the Respondent as they have provided no evidence regarding the same, furthermore not only is the domain name in dispute identical to the registered trade mark of the Complainants, the domain name in dispute

has been found to, previously and currently, offer services and products that are identical to those provided by the Complainant in their line of business as well as providing links to other websites by specifically using the Complainant's trade mark and products i.e. "Daily Jang Urdu", "Daily Jang News", "Daily Jang", "Jang Urdu Pakistan" and "Jang Urdu Pakistan", as discussed in detail within Section 5 of this decision, thereby creating additional confusing similarity in this Panel's opinion.

III. Legitimate interest in Domain Name

As per paragraph 4(c) the UDRP requires the Respondent's claim to be of legitimate interest and shall be :

"proved based on all evidence presented" that *"shall demonstrate"* the Respondent's *"rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii)."*

Evidently the onus of proving any of the above conditions, including legitimate interest, rests solely upon the Respondent as laid out in the UDRP and even otherwise under Rules of Evidence, since the party that asserts legitimate interest must be able to conclusively prove the same. It would not be feasible to put the burden of proof upon the Complainant in any event as it is not possible to prove a negative factor.

The Respondent had the opportunity to demonstrate its rights or legitimate interest in the disputed domain name in accordance with paragraph 4(c) of the Policy however has not been able to do so conclusively in the opinion of this Panel due to failure to provide a Response in the required form, the Respondent have no documents or annexure as evidence to demonstrate their legitimate interest in the domain name in dispute or to substantiate their contentions that have been submitted via email and are being considered by the Panel in a limited manner for the sake of completeness alone. Thus the Panel may only decide the matter based upon the Complaint as per section 5(e) of UDRP.

Paragraph 4(a)(ii) states that:

*"(i) before any notice to you of the dispute, your use of, or **demonstrable preparations to use**, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*
*(ii) you (as an individual, business, or other organization) **have been commonly known by the domain name**, even if you have acquired no trademark or service mark rights; or*
*(iii) you are making a **legitimate noncommercial or fair use** of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."*

In this paragraph, the following are listed as circumstances that in particular, but without limitation, would demonstrate a respondent's legitimate interest or right in a disputed domain name:

- i. that the Respondent can show demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;
- ii. that the Respondent has been commonly known by the domain name;
- iii. that the Respondent can demonstrate making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

Even the limited form of response that has been tendered by the Respondent has been found inaccurate by the Panel, as the Respondent contended that his website was dedicated to historical wars, thus the word "Jang" within the disputed domain name was based upon the Urdu translation of the word meaning "war". As discussed in detail in Section 5 of this decision, the Complainant had submitted a copy of the Respondent's website prior to the Respondent receiving notice from DNDRC, whereby the Respondent offered services related to news and the media and specifically incorporating links relating the Complainant, namely "Daily Jang Urdu", "Daily Jang News", "Daily Jang", "Jang Urdu Pakistan" and "Jang Urdu Pakistan" the website. Following the receipt of the Complaint, DNDRC visited the website and found it to be indeed regarding historical wars, however to be temporarily under construction. Upon visiting the disputed domain name <jang.pk> recently, DNDRC found services related to the news and media industry being offered yet again i.e. services in direct competition and similar to those the Complainant is nationally and internationally known to provide. Thus the Panel concludes that the disputed domain name is not based upon the Urdu translation of "Jang" to mean war furthermore the Respondent has not submitted any evidence that establishes its rights or legitimate interests based upon any of the above requirements.

Furthermore, the domain name in dispute has been put up for sale by the Respondent, as can be seen by a link leading off from the website. Thereby creating further doubt with respect to the Respondent's lack of intent to secure monetary commercial gain at the expense of the Complainant, their well-established business and registered trade mark which constitutes evidence of bad faith on part of the Respondent

Therefore the Panel cannot establish any legitimate interest on the part of the Respondent to the dispute domain name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant's behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of its registered trade name or any obvious derivations of it, as part of the disputed domain name.

Subject to the status of the website discussed within Section 5, the Panel concludes that the

Respondents deliberate attempt to mislead the Panel in addition to such use of the disputed domain name cannot be considered *bona fide* due to the fact that on a balance of probabilities, the Respondent, operative in the same country of business as the Complainant, would reasonably have been familiar with the business and trade mark of the Complainant. Based on the evidence submitted by the Complainant and the lack thereof by the Respondent, the Panel was satisfied that the trade mark of the Complainant is substantially well-known and is associated with great value and esteem solely with the Complainant. The Panel was guided by previous WIPO UDRP cases in reaching this conclusion.

“In the Panel’s opinion, the use of the expression “bona fide” in Paragraph 4(c)(i) is sufficient to prevent a respondent who knowingly adopted another’s well known mark as a domain name from claiming the benefit of mere use of or demonstrable preparations to use the domain name in connection with the offering of goods or services prior to notice of a dispute. The Panel accepts that SCANIA is a well known mark in the motor industry, particularly in Sweden, and, accordingly takes the view that the respondent would have been unlikely to have been unaware of the fame of the complainant’s mark SCANIA in the motor industry before adopting the name.”

(See *Scania CV AB v. Leif Westlye*, WIPO Case No. D2000-0169).

It is the view of this Panel that similar reasoning applies to the case at hand and based on all of the above factors, the Panel finds the Respondent to have no rights or legitimate interest in the disputed domain name.

IV. Registration and use of the domain name in bad faith

In regards to the issue of bad faith the Paragraph 4(b) of the UDRP states that:

*“the following circumstances, in particular but **without limitation**, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or*
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or*
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”*

Both Complainant and Respondent operate in the same country. This is suggestive of the fact that the Respondent was aware of the existence and of the business of the Complainant. The fact that the trademark of the Complainant was registered long before the registration of the disputed domain name is suggestive of bad faith on the Respondent's part. Based on the evidence provided the Panel opines that the registered trade mark of the Complainant is well entrenched with the Complainant's entity and is used unstintingly, both in the print and the motion media under the control of the Complainant. The facts therefore indicate conclusively that the Complainant is a relatively well-known enterprise and that its trade mark would hence be recognized publicly and the Respondent could not help but be aware of this trade mark being associated with the Complainant as well as have knowledge of the services and products offered by the Complainant.

As discussed in Section 5 of this decision, the Panel has determined that the Respondent uses the disputed domain name for offering and advertising news, instead of providing an informative web portal regarding historical wars as claimed by the Respondents in their response via email, with the exception of the limited time period following the submission of the Complaint by the Complainant and the notice of the same to the Respondent. Thus the services offered by the Respondent on the disputed domain name are deemed to be in direct competition with the Complainant thereby providing substantial proof of the Respondent's bad faith with respect to the registration and use of the dispute domain name at the cost of the Complainant.

The Respondent vide the domain name in dispute provides services similar to the Complainant provides in the course of its long standing business and it is therefore most likely that the Respondent deliberately used the trade mark of the Complainant within their registered domain name <jang.pk> to create confusion and divert customers of the Complainant.

Furthermore the domain name in dispute is available for sale as can be seen by a link leading off from the website, therefore giving credence to the Complainant's Complaint subject to clause 4(b)(i) of UDRP.

The Respondents have provided no evidence to demonstrate lack of bad faith, additionally the Respondent's deliberate efforts to mislead these proceedings by temporarily altering the domain name in dispute to give credence to their contentions and subsequently changing the website back to offer the same services, in direct competition with the Complainant lays evidence to the Respondent's mala fide. Accordingly, it is the Panel's view that, on the balance of probabilities, the Respondent had actual knowledge of the trademark of the Complainant and the products/services in connection with which the trademark is used by the Complainant. As it was noted in *Herbalife International, Inc v. Surinder S. Farmaha*, WIPO Case No. D2005-0765:

“the registration of a domain name with the knowledge of the complainant’s trademark registration amounts to bad faith.”

In the current proceedings, no indication of any correspondence between the Complainant and/or any representative of Complainant, on one side, with Respondent, on the other, or similar evidence, have been determined to suggest or imply that the Complainant may have approved of or condoned the Respondent’s use of their registered trade mark. Without any form of substantial evidence to indicate that the Complainant approved of or condoned the Respondent’s use of their trade mark in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

In conclusion, the Panel finds that the test under paragraph 4(b) has been established successfully by the Complainant.

9. Policy cited by Respondent

The Respondent in his response via email dated 26th August, 2008 contended that the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 states:

“There is no restriction for generic dictionary names, and these can be registered under any .pk name”

However the accurate reproduction of the appropriate section of the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 states:

*14. There is no restriction for generic dictionary names, and these can be registered under any .pk name, **unless precluded by some other clause of this agreement.***

Therefore the Panel finds that the contention of the Respondent pertaining to the generic nature of the word “Jang” is not persuasive argument as the applicability of this section is subject to other clauses of the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4., including Para 1 and 4, under which the Respondent’s registration of the disputed domain name has already been found illegal and invalid due reasons of obvious derivation from a registered trade mark, lack of bona fide on the part of the Respondent as well as non-compliance with applicable Pakistani legislation.

The Complainant’s registered trade mark “Jang” cannot be used as a generic dictionary word as this mark *“is properly categorized as ‘suggestive’ of the services. A suggestive mark requires imagination and perception to determine the nature of the goods or services”* as noted in *Pet Warehouse v. Pets.Com, Inc* WIPO Case No. D2000-0105, *“the mark is used in connection with catalog retail services and related Internet retail services. It does not simply signify..the generic*

use of the phrase. Some degree of imagination is required to ascertain the nature of ... use of the mark.”

Therefore the word “Jang” requires some degree of imagination to determine the manner in which it shall be utilized, as it is a translation of an Urdu word and is not commonly understood. Additionally the Respondent’s actions show that he has not utilized the word “Jang” in its generic dictionary meaning as claimed by him, and conversely can be seen to be using it in connection with the offering of similar services as offered by the Complainant i.e. news and media related, in direct competition with the Complainant. Therefore the Respondent can be seen to be using the word “Jang” as a direct link to the Complainant’s business and registered trade mark, in a manner that will negatively affect the Complainant’s business, deflect its customers and tarnish its reputation, therefore the word “Jang” cannot be seen to be used in a generic manner by the Respondent and results in an abusive registration of the domain name in dispute <jang.pk>.

As seen above the Respondent has not provided conclusive evidence to refute the Complaint and his deliberate actions intended towards misleading this Panel have served to compound the damage. Thus the Panel concludes that the Respondent has not successfully been able to prove legitimate claim on the domain name in dispute <jang.pk>

10. Decision

For the foregoing reasons, the Panel therefore concludes and decides that:

- i. The Respondent’s registration of the disputed domain name <jang.pk> is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the disputed domain name.
- iii. The disputed domain name identical to the Complainant’s trade mark and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant’s trade mark.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the domain name at issue <jang.pk> to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Mustafa Syed

Sole Panelist

Dated: 10th June, 2009